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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,622	08/17/2001	William R. Kowalski	2001-5	6302

7590 06/01/2007  
Martin E. Hsia  
P. O. Box 939  
Honolulu, HI 96808-0939

EXAMINER

MAHAFKEY, KELLY J

ART UNIT	PAPER NUMBER
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1761

MAIL DATE	DELIVERY MODE
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06/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/932,622

Applicant(s)

KOWALSKI, WILLIAM R.

Examiner

Kelly Mahafkey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-11,13,14,17,18,20,24 and 103-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,13,14,17,18,20,24 and 103-109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

Applicant's amendments made 5/7/07 have been entered.  
Claims 1-4, 6-11, 13, 14, 17, 18, 20, 24, and 103-109 remain pending.

***Examiner Note***

Applicant's drawings page 9/10 has been received.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/7/07 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6-9, 14, 17, 18, 20, 24, and 103-109 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating fish, wherein a gas is introduced into the animal through water which is passed through the respiratory and circulatory system of the fish and the membranes of the fish act to super purify the gas, does not reasonably provide enablement for the same process with any "meat" or "live animal". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The breadth of the claims are directed to a method for treating a meat or live animal in which a gas is introduced into the animal through water which is passed through the respiratory and circulatory system of the meat or animal, wherein the

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membranes of the meat or animal act to super purify the gas. The nature of the invention is directed specifically toward fish and not toward all meat or live animals. Furthermore, the direction and working examples provided by the inventor are also directed specifically toward fish and not toward all meat or live animals. It is unclear as to how the claimed method could be applied to a land-based animal (i.e. a cow), or even to all sea animals (i.e. a clam). For example, in applicant's response 5/7/07 (page 12), applicant argues that the gas must be passed "through the gills" of the animal. It is unclear as to how one of ordinary skill in the art would apply the claimed method to an animal without gills or a super purifying membrane.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. It is noted that the rejection below was necessitated by amendments.

Claims 1-4, 6-11, 13, 14, 17, 18, 20, 24, and 103-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisateru in view of Yamaoka et al. (US 5484619). The references and rejection are incorporated herein and as cited in the office action mailed November 2, 2006.

### ***Response to Arguments***

Applicant's arguments filed May 7, 2007 have been fully considered but they are not persuasive.

Applicant argues that the references of record do not teach, "preventing smoke flavor from entering the meat of the fish". Applicant further argues that "preventing smoke flavor from entering the meat of the fish" is a totally unexpected result and totally new function of the method as taught by Hisateru in view of Yamaoka. This argument is not convincing as all of the active method steps claimed are taught by the references of record and thus one of ordinary skill in the art would expect the same results as instantly claimed, absent any clear and/or convincing arguments and/or evidence to the contrary. At the present time, applicant's arguments are not convincing.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a method of preservation "consisting SOLELY of passing smoke through the gills and circulatory system of the fish") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claims recite a method "comprising" various steps. It is noted that the term "comprising" means that while the steps claimed are present, other method steps may also be included in the process; the term "comprising" does not limit the method steps in the claims. It is further noted that the term "consisting of" does limit the method steps in the claims.

In response to applicant's argument that Yamaoka is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Yamaoka is in the field of applicant's endeavor, Yamaoka is directed to the method of preserving fish, as is applicant.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case Hisateru teaches of a method of preserving live fish with carbon monoxide and Yamaoka teaches of a method of maximizing the preservation of fish with a mixed gas, including carbon dioxide and carbon monoxide, thus one would have been motivated to use a gas with carbon monoxide and carbon dioxide in order to obtain maximum preservation of the fish.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Mahafkey whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Mahafkey  
Examiner  
Art Unit 1761



**KEITH HENDRICKS**  
**PRIMARY EXAMINER**